

REMARKS

Applicant has carefully reviewed the Official Action dated August 25, 2004 for the above identified patent application.

Independent Claim 1 has been revised to include a preamble which more accurately describes the nature of the invention disclosed in Applicant's specification. The form of dependent Claims 2 - 12 has been revised to conform to the revision made to independent Claim 1. Method Claims 13 - 17, which parallel apparatus Claims 1 - 5, have been added to this application.

No fee for the additional claims is enclosed since the cost of the added claims is covered by the basic filing fee previously paid for this patent application.

In the Official Action dated August 25, 2004, Claims 1 and 2 have been rejected under 35 U.S.C. Section 103(a) as being obvious over the previously applied Herron patent in view of the previously applied Scott patent. Claims 1 - 2, 4 - 5 and 7 have been rejected under 35 U.S.C. Section 103(a) as being obvious over the previously applied Winston publication in view of the Scott patent. Claims 3 and 6 have been rejected under 35 U.S.C. Section 103(a) as being obvious over the Herron patent in view of the Scott patent and in further view of the previously cited Foulkes et al patent. Claims 3, 6, 8 and 10 - 12 have been rejected under 35 U.S.C. Section 103(a) as being obvious over

the Winston publication in view of the Scott patent and in further view of the Foulkes et al patent.

The specific basis for the rejection of the claims is set forth in the Official Action. Applicant notes that the prior art rejections raised in the outstanding Official Action are identical to the prior art rejections raised in the Final Action dated February 25, 2004.

At page 6 of the latest Official Action, the Examiner replies to Applicant's arguments presented in response to the earlier prior art rejections (which, as noted above, are identical to the prior art rejections in the outstanding Official Action) are as follows:

"Regarding applicant's arguments that the new limitations "A tube-formed rock bolt for stabilizing bore holes drilled in the earth in conjunction with rock drilling operations" will make the claim allowed over the Prior Art of record (Page 5 Line 14), this new limitation is considered as the intended use of the device.

A recitation with respect to the manner in which an apparatus is intended to be employed does not impose any structural limitation upon the claimed apparatus, which differentiates it from a prior art reference disclosing the structural limitations of the claim. [citations omitted] Therefore, the rejection of the claims stands."

Applicant initially notes that the recitation "in the earth" has been deleted from independent Claim 1 in the Supplemental Amendment filed on July 1, 2004. Moreover, the pending apparatus Claims 1 - 12 have now been amended to include a preamble which,

in structural terms, positively recites the nature of the invention. It is well established that limitations in the preamble of the claim must be considered in determining the patentability of a claim when the limitations in the preamble are necessary to give meaning to the claim and properly define the invention. Perkin Elmer Corp. v. Computervision, Inc., 221 USPQ 669 (Fed. Cir. 1984). See also, Gerber Garment Technology, Inc. v. Lectra Systems, Inc., 16 USPQ 2d 1436 (Fed. Cir. 1990); and Rockwell International Corp. v. United States, 47 USPQ 2d 1027 (Fed. Cir. 1998). A term in the preamble of a claim that "breathes life and meaning" into the subject matter of that claim is a necessary limitation on the scope of the claim. Loctite Corp. v. Ultraseal Ltd., 228 USPQ 90 (Fed. Cir. 1985).

The preamble of independent Claim 1 now positively recites "a tube-formed rock bore hole stabilizing bolt" which more clearly defines the nature of the claimed invention, and provides a positively recited structural limitation entitled to patentable consideration. See, Rockwell International Corp. v. United States, supra. The preamble also breathes life and meaning into the claim since it supports subsequent recitations in the body of the claim, as for example, the recitation that the tube (1) expands against a rock bore hole. Applicant respectfully submits that the preamble of independent Claim 1 positively recites structure which is necessary to both properly define the nature of the claimed invention and to breathe life and meaning into the claim, is not a statement of intended use, and is therefore a

positively recited structural limitation entitled to consideration in the patentability determination.

Each of the two rejections of independent Claim 1 raised in the outstanding Official Action is based, in part, on the Scott patent. The Scott patent has been applied as follows: "Scott teaches that it is known in the art to have an elongated tube (10) having a varying material thickness in a peripheral direction when measured perpendicularly to the outer surface of the tube (Figure 4)." [Official Action, 8/25/04, paragraphs 3 & 4].

Applicant respectfully disagrees with the rejection of independent Claim 1 based in part on the Scott patent. As discussed during the prosecution of this patent application, the Scott patent is directed to a conventional household wall plug, and not a rock bore hole stabilizing bolt. As more fully discussed at pages 6 - 7 of the Amendment filed by Applicant on June 28, 2004, the purpose and nature of a conventional wall plug as disclosed by the Scott patent is significantly different from a rock bore hole stabilizing bolt as disclosed and claimed by Applicant. As a result of the significant differences between the nature of the wall plug disclosed in the Scott patent and the nature of the rock bore hole stabilizing bolt disclosed and claimed by Applicant, Applicant submits that it would not be obvious for one skilled in the relevant art, namely the rock drilling art, to combine the Scott patent which is directed to

problems different from those encountered in connection with stabilization devices used in conjunction with rock drilling operations, with prior art directed to the relevant subject matter, namely, stabilization bolts used in conjunction with rock drilling operations. In fact, the Scott patent advocates the use of a wall plug made of a plastic material (See, for example, the discussion at page 6 of Applicant's Amendment filed on June 28, 2004), a material which would be totally inappropriate for use in a rock bore hole stabilizing bolt as disclosed and claimed by Applicant.

As a result of the distinctly different objectives of the wall plug disclosed by the Scott patent and the rock bore hole stabilizing bolt disclosed and claimed by Applicant, and as a further result of the significant differences between the problems encountered by the respective devices in their customary intended operating environments, Applicant submits that there is clearly no suggestion in the relevant art itself to combine the Scott patent with any of the other references applied to reject independent Claim 1 in the outstanding Official Action. On the contrary, since the prior art itself does not suggest or motivate one skilled in the art to combine the Scott patent with any of the other applied references, the only basis for the combination of such non-analogous art must be derived from the use of Applicant's own disclosure as a guide for selectively combining different portions of different prior art references to reconstruct independent Claim 1. However, a hindsight

combination of only selected portions of different references, using Applicant's disclosure as a guide for combining "the right references in the right way", is an improper basis for rejection of a claim, as a matter of law. See, for example, Orthopedic Equipment Co. v. United States, 217 USPQ 193 (Fed. Cir. 1983); In re Fritch, 23 USPQ 2d 1780 (Fed. Cir. 1992); and Micro-Chemical, Inc. v. Great Plains Chemical Co., Inc., 41 USPQ 2d 1238 (Fed. Cir. 1997).

For the reasons discussed above, Applicant submits that independent Claim 1 is allowable over the prior art applied in the Official Action. Claims 2 - 12, which depend directly or indirectly from independent Claim 1 and thus include all features of the parent independent claim, are allowable at least for the same reasons as parent independent Claim 1.

Claim 13 - 17 are directed to methods for stabilizing bore holes drilled in conjunction with rock drilling operations, the steps of the methods including inserting a tube-formed rock bolt in a bore hole. Method Claims 13 - 17 generally parallel apparatus Claims 1 - 5. The rock bolt expressly defined in independent method Claim 13 corresponds to the rock bolt recited by independent apparatus Claim 1. Applicant respectfully submits that independent method Claim 13 is allowable over the prior art applied in the outstanding Official Action for the same reasons discussed with respect to independent apparatus Claim 1, namely, that the prior art does not teach or suggest a method for

stabilizing bore holes drilled in conjunction with rock drilling operations, the steps of the method including inserting into a bore hole a tube-formed rock bolt having a tube with a varying material thickness in a peripheral direction when measured perpendicularly to the other surface of the tube. Method Claims 14 - 17, which depend directly or indirectly from independent parent method Claim 13 and thus include all features of the parent independent claim, are allowable at least for the same reasons as parent independent method Claim 13.

Applicant respectfully submits that all pending claims are in condition for allowance, and favorable action is respectfully requested.

Respectfully submitted,



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